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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/433,761	11/04/1999	JOHN A. RUSHING	UMB-LITES	2970

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EXAMINER
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TON, ANABEL

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 11/20/2002

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 14

Application Number: 09/433,761  
Filing Date: November 04, 1999  
Appellant(s): RUSHING, JOHN A.

John A. Rushing  
For Appellant

**EXAMINER'S ANSWER**

**MAILED**

NOV 20 2002

**GROUP 2800**

This is in response to the appeal brief filed August 21, 2002.

**(1) Real Party in Interest**

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is not correct, in view of the withdrawal of the heretofore outstanding rejection of claims 6 through 9 under 35 U.S.C. 112, 2<sup>nd</sup> paragraph.

Consequently, this appeal involves claims 1 through 5.

Claims 6 through 9 are objected to as being dependent on rejected base claim 1, but these claims would be allowable if rewritten to include all the limitations of the base claim and any intervening claims.

Claim 10 is allowed.

**(4) *Status of Amendments After Final***

The Appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on 01/30/02 has not been entered.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) Issues**

The Appellant's statement of the issues in the brief is substantially correct. The changes are as follows: Claims 6 through 9 are no longer rejected under 35 USC 112 second paragraph.

**(7) Grouping of Claims**

The rejection of claims 1 through 5 stand or fall together because Appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

6,224,239	Adler	5/2001
3,968,398	Lehmann et al	07/1976

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 through 4 stand rejected under 35 U.S.C. 102(b) as anticipated by Adler. This rejection is set forth in prior Office Action, Paper No. 7.

Claim 5 is rejected under 35 U.S.C. 103 (a) as being obvious over Adler, as applied to claims 1 through 4, and further in view of Lehmann et al. This rejection is set forth in prior Office Action, Paper No. 7.

**(11) Response to Argument**

With regards to the 35 USC 112 second paragraph rejection of claims 6 through 9, Appellant's arguments relating this rejection are deemed persuasive. The rejection of claims 6 through 9 under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, is moot in view of Appellant's response.

With regard to Appellant's arguments relating to the rejection of claims 1 through 4 as anticipated by Adler, the following response applies: Adler does indeed recite and teach, clearly in figures 1 and 2, minimally spaced apart light strings. With regards to the argument that the strings do not extend from the power cord but are located on the power cord, it is submitted that if the light strings were not "extending from the power cord" they would not function, for there would not exist an electrical connection to provide electrical power to induce the bulbs on the light strings to illuminate.

With regards to there being no mention in Adler of the light strings being connected to the power cord in series or in parallel, one need only review column two, lines 33-35, of the Adler reference wherein is recited, verbatim, "lights 18 arranged at spaced intervals along the wire 19 in series or parallel". With regards to Appellant's argument that Adler is creating a decorative light fixture in the form of an icicle, although this is a true statement, it does not remove the validity of Adler's spaced apart light strings extending from a power cord connected in series or in parallel with the power cord that are

contained within the icicle sheaths and likewise recited as part of the title of the invention.

With regards to Appellant's argument that the combination of the Adler and Lehmann et al references are inappropriately combined, with respect to claim 5, Lehmann et al reference teaches a decorative light string set that incorporates a short circuit protection device which renders the light string safe in the event of electrical malfunction. Adler discloses a decorative light string. To implement a circuit protection device in a decorative light string, as taught by Lehmann et al, would have been obvious in the art. To incorporate this feature into a decorative light string such as Adler's would provide a light string that would be protected from a short circuit thereby enhancing the light string's features. Furthermore, it has been held that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

With regard to the contention that there is no proof provided of the circuit the Appellant is claiming, as shown by Adler, the option of the lights arranged at spaced intervals along the wire in series or parallel is provided in lines 33-35, column 2 of Adler. Finally, connecting light strings in series to the cord would provide a light string that would use bulbs of lower voltage, since connecting them in series would divide the voltage

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provided among the bulbs. Also, series connection would create a lighting assembly that emits less heat and is cost effective since the bulbs require less of a voltage to function. Furthermore, connecting these strings in turn in parallel would provide an electrical arrangement so that when one bulb fails on a light string the remaining bulbs would remain illuminated.

For the above reasons, it is believed that the rejections should be sustained.

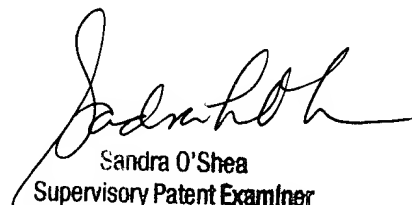
Respectfully submitted,

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AMT  
November 18, 2002

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